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10/527,231	03/09/2005	Murali Punaganti	60091.00383	2870

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SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER	
APPIAH, CHARLES NANA	
ART UNIT	**PAPER NUMBER**
2617	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/527,231	PUNAGANTI ET AL.	
	Examiner	Art Unit	
	Charles N. Appiah	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *17-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 20-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *17-19* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 17-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented claims 1-16 and 20-30 are directed to a method and an apparatus for processing a voice call establishment request from a calling terminal to a called terminal and newly submitted claims 17-19 are directed to a mode converter for changing a call mode from a voice call to a non-voice. The invention of claims 1-16 and 20-30 are distinct and unrelated to the invention of claims 17-19.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2. Applicant's arguments filed on February 17, 2006 have been fully considered but they are not persuasive. With respect to Applicants' argument that "in Higuchi, a two-way communication has been allowed", because "when a cellular telephone apparatus 1. See column 6, lines 4-14", examiner maintains that the claim calls for "two-way voice call between the calling terminal and called terminal is not allowed" not "two-way communication between the calling terminal and the called terminal is not allowed" as being argued by applicant and as such Higuchi as set forth in the rejection still meets

the claimed limitation of determining a two-way voice call between a calling terminal and a called terminal is not allowed, since clearly " a user not responding to the incoming call notification constitute two-way voice call is not allowed.

Additionally, Higuchi's teaching of the transmission of an absence message for notifying the calling party that the user is now absent, col. 6, lines 19-24), clearly meets "conveying information based on said silent messages to the calling terminal and/or the called terminal respectively", irrespective of the "communication channel being cut and the cellular mobile telephone again entering the standby state when the calling party cuts the call or the, as being argued by the applicant.

With respect to Applicant's argument that "Higuchi is devoid of any teaching or suggestion ... providing a determination based on detecting a predetermined profile associated with the called terminal, the profile being set prior to said alerting", examiner maintains that the cited portion of Higuchi, specifically col. 5, lines 54-56 and col. 7, lines 26-40, clearly meets a profile associated with the called terminal (user) being set prior to the alerting.

With respect to applicants' argument that Lele does not teach or suggest that "a two-way voice call between the calling terminal and the called terminal is not allowed", examiner maintains that Lele's teaching message indicative of a busy operational mode clearly meets the indication that "a two-way voice call between the calling terminal and the called terminal is not allowed".

In view of the above the rejections using Higuchi and Lele are maintained as repeated below. This action is made FINAL

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Higuchi et al. (6,275,690).

Regarding claims 1, 11 and 14 Higuchi discloses a method and an apparatus for processing a voice call establishment request from a calling terminal to a called terminal, the method comprising: detecting the call establishment request (mobile telephone entering standby state and remaining in this state until receiving call reception signal destined thereto, see col. 6, lines 4-7), in response to the detecting alerting the called terminal (recognition of incoming call and letting the user know of the reception of an incoming call with incoming call notification, see col. 6, lines 7-13), setting up a two-way connection between the calling terminal and the called terminal (receiving of call reception signal, col. 6, lines 5-19), determining that a two-way voice call between the calling terminal and the called terminal is not allowed (user does not respond to the provided incoming call notification , see col. 6, lines 19-22), and receiving silent messages via user interface of the called terminal and/or calling terminal and conveying information based on the silent messages to the calling terminal and/or called terminal respectively (transmission of absence message for notifying the calling

party that the user is now absent and initiating a recording operation, see col. 6, lines 22-37).

Regarding claim 2, Higuchi further discloses wherein the determining is based on detecting a predetermined input via the user interface of the called terminal after the alerting (user responding by manipulating a key while the reception of the incoming call is being notified to the user, see col. 6, lines 38-49).

Regarding claim 3, Higuchi further discloses wherein the determining is based on detecting a predetermined profile associated with the called terminal, the profile being set prior to the alerting (storage of messages generated for responding to an incoming call, see col. 5, lines 37-67, col. 6, lines 60-67 and col. 7, lines 26-40).

Regarding claim 4, Higuchi further discloses wherein the two-way connection is or comprises a chat connection (entering of communication state with an any-key-answer function invocation, see col. 6, lines 45-49).

5. Claims 1-13, 14, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lele et al. (6,185,433).

Regarding claims 1, 11 and 14 Lele discloses (with reference to Fig. 5), a method and an apparatus for processing a voice call establishment request from a calling terminal to a called terminal, the method comprising: detecting the call establishment request (receive voice communication from calling device, step 503, col. 8, lines 51-58), in response to the detecting, alerting the called terminal (transmission of voice communication to called device, step 505, col. 8, lines 57-58 and col. 4, lines 4-11), setting up a two-way connection between the calling terminal and the called

terminal (see col. 8, lines 55-58), determining that a two-way voice call between the calling terminal and the called terminal is not allowed (called device being in the busy operational mode, see col. 8, lines 55-62), and receiving silent messages via user interface of the called terminal and/or calling terminal and conveying information based on the silent messages to the calling terminal and/or called terminal respectively (reception of data message from the called device indicating that the called device is in the busy operational mode, see col. 8, lines 59-64).

Regarding claim 2, Lele further discloses wherein the determining is based on detecting a predetermined input via the user interface of the called terminal after the alerting (see col. 4, lines 12-29).

Regarding claim 3, Lele further discloses wherein the determining is based on detecting a predetermined profile associated with the called terminal, the profile being set prior to the alerting (plurality of user defined messages pre-stored in the memory of the called device, col. 7, lines 25-44).

Regarding claim 4, Lele further discloses wherein the two-way connection is or comprises a chat connection (see col. 3, line 55 to col. 4, line

Regarding claims 5 and 6, Lele discloses wherein the conveying comprises converting the silent messages to speech wherein the converting comprises text-to-speech synthesis (calling device does not include a text message display, user being informed of the target user's busy operational mode by converting the data message to a voice message, see col. 8, lines 36-50).

Regarding claims 7 and 8 Lele further discloses wherein the converting comprises receiving an indication of one of a plurality of predetermined voice messages, wherein the plurality of predetermined voice messages is dimensioned such that any predetermined voice message is selectable without moving fingers on the user interface (see col. 7, lines 21-43).

Regarding claim 9, Lele further discloses wherein the determining step is carried out by a network element (infrastructure receiving data message from the called device indicating that the called device is in the busy operational mode, see col. 8, lines 59-64).

Regarding claim 10, Lele further discloses wherein the converting step is carried out by a network element (see col. 8, lines 44-50).

Regarding claims 12 and 15, Lele further disclose wherein the apparatus is located in a network element (see col. 8, lines 51-54).

Regarding claims 13 and 16, Lele further discloses wherein the apparatus is located in the called terminal (see Fig. 3, col. 56-65).

6. Claims 1,2, 4-6, 9-12, 14, 15, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannell et al. (6,741,678).

Regarding claims 1, 11, 14 and 23, Cannell discloses method and an apparatus for processing a voice call establishment, and a communication system (see Figs. 1-2), the system configured to detect a voice call establishment request from a calling terminal to a called terminal (calling terminal sends call request to called phone, step 201), in response to the detecting, alert the called terminal (called phone receives

the call request from the calling phone, step 203), set up a two-way connection between the calling terminal and the called terminal (steps 201-203), determine that a two-way voice call between the calling terminal and the called terminal is not allowed (called terminal not answering the request, step 205), and receive silent via the called terminal and/or calling terminal (called phone wishing to send data message and calling phone being data-capable, steps 207-211), and convey information on the silent messages to the calling terminal and/or the called terminal, respectively (data message and/or voice message being sent to calling phone , steps 210, 211, 213, 215).

Regarding claim 2, Cannell further discloses wherein the determining is based on detecting a predetermined user input via a user interface of the called terminal after the alerting (called terminal wishing to send a data message to the calling terminal, see col. 4, lines 27-30).

Regarding claim 4, Cannell further discloses wherein the two-way connection is or comprises a chat connection sending of data message to calling phone, step 210).

Regarding claim 5, Cannel further discloses wherein the conveying comprises converting the silent messages to speech (convert data message to voice message, step 213).

Regarding claim 6, Cannell further discloses wherein the converting comprises text-to-speech synthesis (see col. 5, lines 1-7).

Regarding claim 9, Cannell further discloses wherein the determining step is carried out by a network element (see col. 4, lines 4-14).

Regarding claim 10, Cannel further discloses wherein the converting step is carried out by a network element (see col. 3, lines 14-25).

Regarding claims 12 and 15, Cannel further discloses wherein the apparatus is located in a network element (see col. 3, lines 5-28).

Regarding claim 20, Cannell discloses a user interface in a called terminal and/or a calling terminal (calling phone, called phone), wherein the user interface is configured to select a desired call mode (user of the called phone deciding not to answer the call in the usual manner, col. 1, lines 53-60), if a two-way voice call between the called terminal and the calling terminal is not allowed (user of the called phone being in a setting that is not conducive to completing and carrying on a conversation, see col. 1, lines 60-65), receive silent messages from the calling terminal and/or the called terminal (called phone responding to the call request with a data message, which is sent to the calling terminal without completing the call, see col. 1, line 66 to col. 2, line 3). See Figs. 1-2.

Regarding claim 21, Cannell further discloses wherein the silent messages are chat responses (data message being sent to calling phone, see Fig. 2, steps 209-215).

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 3, 22, 24-27, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannell et al as applied to claims 1, 11, 14 and 23 above, and further in view of Brown et al. (7,010,288).

Regarding claims 3, 27, 28 and 30, Cannell fails to teach that the determining is based on detecting a predetermined profile associated with the called terminal, the profile being set prior to alerting.

In an analogous field of endeavor, Brown discloses a method and system for providing an automatic response to a telephone call wherein a phone that stores one or more voice or text messages which may be sent in response to an incoming call as an auto-response feature (see col. 3, lines 36-64, col. 4, lines Fig. 2, col. 4, lines 40-59). According to Brown a database may be accessed in order to select from a plurality of pre-recorded messages in order to determine the appropriate pre-recorded message to be transmitted (see col. 2, lines 37-42), wherein the algorithm that is used may be based on contacts e.g., a button (or message) for family, friends, work contacts, unknown callers, telemarketers, etc., including customizing auto-responses depending on the activity of the user, the identity of the caller, etc. (see col. 7, line 60 to col. 8, line 18), which reads on predetermined profile associated with the called terminal which is set prior the alerting.

It would therefore have been obvious to one of ordinary skill in the art to provide for incoming call auto-response based on predetermined user profile in order to avoid users having to constantly change their outgoing or response messages to incoming calls.

Regarding claim 26, the combination of Cannell and Brown as applied above to claim 3 meet all limitations. Additionally Brown further teaches executing a plurality of options in the predetermined profile according to rules in the predetermined profile (see

setting up algorithm for a message for family, friends, work contacts, unknown callers, telemarketers, etc., see col. 8, lines 1-5).

Regarding claim 22, Cannell fails to teach wherein the user interface is configured to select predetermined voice messages such that any predetermined voice message is selectable by a user without moving fingers on the user interface.

In an analogous field of endeavor, Brown discloses a method and system for providing an automatic response to a telephone call wherein a phone that stores one or more voice or text messages which may be sent in response to an incoming call as an auto-response feature (see col. 3, lines 36-64, col. 4, lines Fig. 2, col. 4, lines 40-59). According to Brown a database may be accessed in order to select from a plurality of pre-recorded messages in order to determine the appropriate pre-recorded message to be transmitted (see col. 2, lines 37-42).

It would therefore have been obvious to one of ordinary skill in the art to combine Brown's auto-response feature with Cannel's communication system in order to improve the experience associated with responding to calls in which a called person is unavailable or not in a position to answer the call as taught by Brown.

Regarding claims 24-25, Cannell fails to explicitly teach presenting an audio alert or a visual alert in the called terminal.

Brown discloses wherein different forms of alert such as activation of a ringer (audio), visual notification are used to inform a user of an incoming call (see col. 4, lines 29-39).

It would therefore have been obvious to one of ordinary skill in the art to provide Brown's means of incoming call alert means such as audio and visual to Cannel's system in order to minimize disruptive noise in situations where a user does not want to be disturbed with prolonged telephone ringing sounds.

Regarding claim 29, Cannell fails to explicitly disclose that when determining that two-way voice call between the called terminal and the calling terminal is not allowed, the determination is based on detecting a prior set predetermined profile associated with the called terminal.

In an analogous field of endeavor, Brown discloses a method and system for providing an automatic response to a telephone call wherein a phone that stores one or more voice or text messages which may be sent in response to an incoming call as an auto-response feature (see col. 3, lines 36-64, col. 4, lines Fig. 2, col. 4, lines 40-59). According to Brown a database may be accessed in order to select from a plurality of pre-recorded messages in order to determine the appropriate pre-recorded message to be transmitted (see col. 2, lines 37-42), wherein the algorithm that is used may be based on contacts e.g., a button (or message) for family, friends, work contacts, unknown callers, telemarketers, etc., including customizing auto-responses depending on the activity of the user, the identity of the caller, etc. (see col. 7, line 60 to col. 8, line 18), which reads on predetermined profile associated with the called terminal which is set prior the alerting.

It would therefore have been obvious to one of ordinary skill in the art to provide appropriate responses to incoming calls based on predefined rules corresponding to a subscriber's stored profile as taught by Brown.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith (US 2005/0130639) discloses a system for integrating call delivery for fixed site and mobility services.

Henriksson (5,845,219) discloses a mobile station having priority call alerting function during silent service mode.

Rautila et al. (6,631,183) discloses an operating mode dependent call answering service.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

CHARLES APPIAH
PRIMARY EXAMINER